



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/580,070

05/19/2006

Toru Shimizu

053673-0030

9492

20277 7590 05/10/2010
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

MOORE, WALTER A

ART UNIT

PAPER NUMBER

1783

MAIL DATE

DELIVERY MODE

05/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,070	Applicant(s) SHIMIZU ET AL.	
	Examiner WALTER MOORE	Art Unit 1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2009 and 29 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,11-14,16-20,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8, 11-14, 16-20, and 23-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

Status of Claims

1. Claims 1, 3-6, 8, 11-14, 16-20, and 23-24 are pending. Claims 2, 7, 9-10, 15, and 21-22 were canceled, claims 1, 3-6, 8, 11-14, 16-20, and 23-24 were amended in the response filed on 12/22/2009.

Acknowledgment of Documents

2. The amendments to the Abstract and Specification, filed on 12/22/2009, have been entered into the application.
3. The amendment to the Specification, filed on 1/29/2010, has been entered. The amendment corrected a typographical error in a reference citation. Examiner notes the reference was considered in the IDS filed on 5/19/2006.

Withdrawn Rejections

4. The objections to the Abstract, made of record in the office action mailed on 7/21/2009, have been withdrawn due to applicant's amendment, filed on 12/22/2009.
5. The objections to claims 4, 5, and 7-16, made of record in the office action mailed on 7/21/2009, have been withdrawn due to applicant's amendment, filed on 12/22/2009.
6. The 35 USC 102 rejections of claims 1, 3, 5, 7-8, and 17-20 as anticipated by Nelson, made of record in the office action mailed on 7/21/2009, have been withdrawn due to applicant's amendment filed on 12/22/2009.

Art Unit: 1783

7. The 35 USC 103 rejection of claim 14, as obvious over Nelson in view of Nakatsu, made of record in the office action mailed on 7/21/2009, has been withdrawn due to applicant's amendment filed on 12/22/2009.

8. The 35 USC 103 rejections of claims 1-6, 9-10, 17-18, and 21-22, as obvious over Chapdelaine '574 in view of Chapdelaine '971, made of record in the office action mailed on 7/21/2009, has been withdrawn due to applicant's amendment filed on 12/22/2009.

9. The 35 USC 103 rejections of claims 13 and 15, as obvious over Chapdelaine '574 in view of Chapdelaine '971 in view of Nakatsu, made of record in the office action mailed on 7/21/2009, has been withdrawn due to applicant's amendment filed on 12/22/2009.

10. The 35 USC 103 rejection of claim 4, as obvious over Chapdelaine '574 in view of Chapdelaine '971 in view of Spencer, made of record in the office action mailed on 7/21/2009, has been withdrawn due to applicant's amendment filed on 12/22/2009.

11. The 35 USC 103 rejections of claims 11-12 and 23-24, as obvious over Chapdelaine '574 in view of Chapdelaine '971 in view of Tezuka, made of record in the office action mailed on 7/21/2009, has been withdrawn due to applicant's amendment filed on 12/22/2009.

12. The 35 USC 103 rejection of claim 16, as obvious over Chapdelaine '574 in view of Chapdelaine '971 in view of Tezuka in view of Nakatsu, made of record in the office action mailed on 7/21/2009, has been withdrawn due to applicant's amendment filed on 12/22/2009.

REJECTIONS

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

14. Claim 3 is objected to because acesulfame K is spelled incorrectly. Appropriate correction is required.

Claim Rejections - 35 USC § 103

15. Claims 1, 3-6, 8, 13-14, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al., USPN 6,570,010, in view of Furman, USPN 5,451,404.

Regarding claims 1, 6, 8, 13-14, and 17-20, Ishida discloses a beverage (carbonated beverage, col. 9, ln. 36) comprising a concentrated fruit juice component (lemon juice concentrate, col. 9, ln. 46), a base with sweetness (liquid sugar dextrose, col. 9, ln. 47), and a flavor improving substance (vanillyl-n-butyl ether, col. 9, ln. 49). Ishida suggests the flavor improving substance (vanillyl-n-butyl ether) can be mixed with beverages that include cool-feeling substances (col. 4, ln. 56) and refreshing feeling substances (col. 4, ln. 61).

However, Ishida does not expressly disclose the beverage includes cool- and refreshing feeling substances.

Furman is drawn to compositions comprising cool feeling substances (col. 1, ln. 8-10). Furman suggests the compositions are useful as beverage additives (col. 1, ln. 13). Furman discloses the composition has improved performance (col. 1, ln. 62-63). Furman discloses the composition includes a refreshing feeling substance (menthol, col. 4, ln. 37) and a cool feeling substance (carboxamide, col. 4, ln. 37). Furman discloses the cool feeling substance can be a cyclic (col. 4, ln. 50) or acyclic carboxamide (col. 5, ln. 20-21).

It would have been obvious to one of ordinary skill in the art at the time of invention to add refreshing- and cool-feeling substances, as taught in Furman, to the beverage composition, taught in Ishida, to obtain a beverage composition comprising refreshing and cool feeling substances. One of ordinary skill in the art would have been motivated to add refreshing and cool feeling substances because they provide enhanced cooling properties to products (col. 1, ln. 60-63).

Regarding claim 3, Ishida discloses the base with sweetness is dextrose (liquid sugar dextrose, col. 9, ln. 47), which is another name for D-glucose.

Regarding claims 4 and 5, Furman discloses the composition has from about 0.0005% to about 0.7% (col. 5, ln. 51). Furthermore, Furman discloses the amount of the composition added to a product will “vary depending upon the particular compound, degree of cooling effect desired and the strength of the other flavorants in the composition” (col. 7, ln. 5-8). In the exemplary compositions, Furman discloses a ratio of refreshing feeling substance (menthol) to a cool feeling substance (Coolant 3 in examples, col. 8, ln. 38, and col. 8, ln. 67) between 3.5 (menthol: coolant 3 = 0.07:0.02 = 3.5; col. 8, Example 3 and 4) and 4.444 (menthol: coolant 3 = 0.4:0.090 = 4.444; col. 8, Example 1 and 2).

Regarding claims 17-20, the phrase, “for reinforcing a flavor,” is a statement of intended use or purpose. A statement with regard to intended use is not further limiting as a manipulative difference between the process claimed and the prior art. In order to patentably distinguish the claimed invention from the prior art, a claimed intended use must result in a manipulative difference between the claimed invention and the prior art. See MPEP § 2111.02 II. In the

Art Unit: 1783

present case there is no manipulative difference from the beverage, taught in Ishida in view of Furman, and the claimed process.

16. Claims 11-12, 16, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al., USPN 6,570,010, in view of Furman, USPN 5,451,404 as applied to claims 1, 3-6, 8, 13-14, and 17-20 above, and further in view of Kaplan, USPA 2002/0182296.

Ishida in view of Furman is relied on as above. Ishida in view of Furman does not disclose the beverage is a fruit juice containing dairy product.

Kaplan is drawn to carbonated milk beverages (p. 1, para 0002). Kaplan discloses the milk beverage can contain a fruit juice (p. 1, para 0002). Kaplan discloses carbonated milk products would be perceived as more healthy alternatives to soft drinks (p. 1, para 0006). It would have been obvious to one of ordinary skill in the art at the time of invention to include a milk product, as taught in Kaplan, in the fruit juice containing beverage, taught in Ishida in view of Furman, to obtain a fruit juice beverage containing milk. One of ordinary skill in the art would have been motivated to include milk because it is viewed as a healthy alternative to soft drinks (p. 1, para 0006).

Regarding claim 16, Ishida discloses an additional flavor improving substance (vanillyl-n-butyl ether, col. 9, ln. 49).

Regarding claims 23 and 24, the phrase, “for reinforcing a flavor,” is a statement of intended use or purpose. A statement with regard to intended use is not further limiting as a manipulative difference between the process claimed and the prior art. In order to patentably distinguish the claimed invention from the prior art, a claimed intended use must result in a

Art Unit: 1783

manipulative difference between the claimed invention and the prior art. See MPEP § 2111.02

II. In the present case there is no manipulative difference from the beverage, taught in Ishida in view of Furman in view of Kaplan, and the claimed process.

Response to Arguments

17. Applicant's arguments with respect to claims 1, 3-6, 8, 11-14, 16-20, and 23-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER MOORE whose telephone number is (571) 270-7372. The examiner can normally be reached on Monday-Thursday 9:00-4:00.

Art Unit: 1783

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WM/

Walter Moore, Examiner AU 1783

5/5/2010

/David R. Sample/

Supervisory Patent Examiner, Art Unit 1783